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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,961	03/22/2005	Katsura Hirai	05170/HG	9075
1933 7590 04/14/2009 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER				
ULLAH, ELIAS				
ART UNIT		PAPER NUMBER		
2892				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/528,961

## Applicant(s)

HIRAI, KATSURA

## Examiner

ELIAS ULLAH

## Art Unit

2892

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3/24/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This office action is in response a RCE filed on 3/24/2009.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/2009 has been entered.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 29-30, 36-37, 43-46 and 48-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamura et al. (Kawamura, Pub. No.: US2003/0068581).

As to claim 29, Kim et al. shows a method for manufacturing an electrical circuit (Fig. 2) comprising a step of forming at least a part of the electrical circuit by impregnating [0248] a conductive polymer (22, 24 in Fig. 2) solution in a solvent [0232] or a conductive polymer dispersed liquid in a dispersant, in a receptive layer 26 formed

on a substrate 20, the conductive polymer exhibiting p-type conduction or n-type conduction [0203-0204 wherein conductive polymer e.g. PEDOT doped with impurities to exhibit either p type or n type].

With regard to claim 30 Kawamura shows after impregnating a solution [0248] or a dispersed liquid containing the conductive polymer in the receptive layer 26 Fig. 2, forming the part of the electrical circuit by evaporating [0193] (at the temperature of 40-100 degrees solution to evaporate or dry) the solvent of the solution contains the conductive polymer (22, 24) or the dispersant of the dispersed liquid contains the conductive layer.

With regard to claims 36-37 Kawamura shows the method for manufacturing the electrical circuit wherein the solution or the dispersed liquid containing the conductive polymer is impregnated in the receptive layer (see above claim 29 discussions) by ejecting the solution or the dispersed liquid containing the conductive polymer onto the receptive layer by a ink-jet printing method 0224].

With regard to claims 43-44, Kawamura shows an electrical conductivity of conductive polymer is 0.01S/cm or more or 1S/cm or more [0239].

With regard to claims 45-46, Kawamura shows the receptive layer 26 is porous (xylene solution is made of porous martial) and contains inorganic particles (see [0204 wherein respective layer is doped by inorganic particle e.g. Au]).

With regard to claims 48-49, Kawamura shows the average particle diameter of the inorganic particles is .003 to .2 um [0220].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-33, 38-39 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al. (Kawamura, Pub. No.: US2003/0068581).

With regard to claims 31-33, Kawamura fails to teach specific ratio of water concentration the solvent of the solution containing the conductive polymer or the dispersant of the dispersed liquid containing the conductive polymer contains 30% or more of water and 5 to 70 % by weight of water soluble organic solvent and 10 to 30 % by weight of a water soluble organic solvent.

However, Kawamura teaches an arbitrary ratio of water in the solvent [0163]. Accordingly, it would have been obvious to one of ordinary skill in art to use teaching Kawamura in the range as claimed, because it has been held that where the general conditions of the claims are disclosed in the prior art, it is not inventive to discover the optimum or workable range by routine experimentation. MPEP 2144.05.

With regard to claims 38-39, Kawamura teaches a general controllability of ejecting conductive polymer [0224], but fails to teach wherein an amount of the conductive polymer impregnated in the receptive layer is controlled by controlling an amount of the ejected conductive polymer per unit area. However, it is typical to control conductive polymer in the ink jet method by per unit area.

With regard to claim 50, Kawamura teaches a hydrophilic binder [0292] and general ratio of inorganic particle [0294], but fails to specific weight ration of the inorganic particle is between 2:1 and 20:1.

However, differences in processing parameters or concentration or temperature or ratio will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ratio or temperature is critical. Where there general conditions of a claim are disclosed in the prior art, it is not inventive to discover the opium or workable ranges by routine experimentation see MPEP 2144.05.

With regard to claim 51, Kawamura teaches the substrate 20 but fails to teach expressly the substrate is a polymer. However it is typical in the art a substrate can be made of polymer.

Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al. (Kawamura, Pub.: US2003/0068581) in view of Kim et al. (Kim, 2003/0099874) of record.

With regard to claims 34-35, Kawamura fails to teach the solution liquid containing the conductive polymer has .001 to 1% by weight of a surfactant and the surfactant is a non-ionic surfactant.

However, Kim teaches the solution liquid containing the conductive polymer has .001 to 1% by weight of a surfactant [0040] and the surfactant is a non-ionic surfactant [0040]. At the time the invention was made; it would have been obvious to a person having ordinary skill in the art to use the solution liquid containing the conductive polymer has .001 to 1% by weight of a surfactant and the surfactant is a non-ionic

surfactant teaching of Kim in the method for manufacturing an electrical circuit of Kawamura because a conductive polymer contain surfactant enable emulsion formation for polymer electrolyte.

Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al. (Kawamura, Pub.: US2003/0068581) in view of Hannah (Hannah, US 6,767,731) of record.

With regard to claims 40-42, Kawamura teaches polymer contains a dopant [0203-0204].

But Kawamura fails to teach the conductive polymer is oligomer having a repeat number of 4 to 19 or a polymer a repeat number of 20 or more; and conductive polymer has a repeat unit of thiophene, vinylene or a substitute compound thereof.

However, Hannah teaches the conductive polymer is oligomer having a repeat number of 4 to 19 or a polymer a repeat number of 20 or more; and conductive polymer has a repeat unit of thiophene, vinylene or a substitute compound thereof (col. 9, lines 14-29). At the time the invention was made, it would have been obvious to a person having ordinary skill in the art to use "the conductive polymer having a different repeat number and repeat unit" teaching of Hannah in the method for manufacturing an electrical circuit of Kawamura, because a conductive polymer with repeat number and unit are able to make alternating bonds and an alternating bonds provides a pathway for free electron charge carriers for a electronic circuit as taught by Hannah in (col. 9, lines 14-29).

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al. (Kawamura, Pub.: US2003/0068581) in view of Namiki (Namiki, US 5,641,559) of record.

With regard to claim 47, Kawamura fails to teach the inorganic particles rare silica particles prepared by a vapor deposition.

However, Namiki teaches silica particles prepared by a vapor deposition method (col. 4, lines 16-21). At the time the invention was made; it would have been obvious to a person having ordinary skill in the art to use "inorganic particles prepared by a vapor deposition" teaching of Namiki in the method for manufacturing an electrical circuit of Kawamura, because prepared inorganic particles by vapor deposition is a conventional method of preparing a inorganic particles for a electronic circuit as taught by Namiki in (col. 4, lines 14-45).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIAS ULLAH whose telephone number is (571)272-1415. The examiner can normally be reached on weekdays, between 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thao Le can be reached on (571) 272-1708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elias Ullah/  
Examiner, Art Unit 2892

/Lex Malsawma/  
Primary Examiner, Art Unit 2892